

REMARKS

Claims 1-20 are pending in this application. Claims 17 and 18 have been withdrawn from consideration as directed to a non-elected invention. New claims 19 and 20 have been added. In view of the following remarks, applicant respectfully requests reconsideration of the claims and submit that the application is in condition for allowance.

This amendment adds claims in this application. A detailed listing of all claims that are, or were, in the application, irrespective of whether the claim(s) remain under examination in the application, are presented above with an appropriate defined status identifier.

Election/Restriction

In the Office Action, the claims were restricted into the following groups:

- I. Claims 1-16, drawn to a construction panel, classified in class 52, subclass 314; and
- II. Claims 17-18, drawn to a method of manufacturing a construction panel, classified in class 52, subclass 741.1.

Applicant hereby confirms the provisional election of Group I, claims 1-16.

Claim Rejections – 35 U.S.C. §103

In the Office Action, claims 1-6 were:

rejected under 35 U.S.C. 103(a) as being unpatentable over Johnston (2096968). Johnston discloses a construction panel in figure V having upper and lower portions... The material of construction has been deemed a matter of choice. One of ordinary skill in the art would have appreciated all of the materials available for use and would have selected any one which fulfilled the intended purposes of his panel.

Applicant respectfully disagrees that Johnston states a prima facie case of obviousness of claims 1-6. In order to:

establish a prima facie case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior



art reference (or references when combined) must teach or suggest all the claim limitations. The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, and not based on applicant's disclosure.

MPEP §2142.

Johnston alone does not meet any of these criteria, much less all of them. The Office Action points to no suggestion or motivation in Johnston or within the art to modify Johnston to achieve the claimed invention. The Office Action also fails to teach or suggest that modifying Johnston to achieve the claimed invention will have any expectation of success. Finally, the Examiner admits that Johnston alone fails to teach or suggest all of the elements of claims 1-6. Additionally, the statement in the Office Action that "the material of construction has been deemed a matter of choice" fails to treat the claimed invention as whole. As stated in the MPEP, a "statement that modifications of the prior art to meet the claimed invention would have been 'well within the ordinary skill of the art at the time the claimed invention was made'... is not sufficient to establish a prima facie case of obviousness [.]" MPEP §2143.01. The only motivation to use the materials of claims 1-6 in the shingle of Johnston are provided by the present invention.

Applicant also submits that the patentability of the claimed invention is being judged under the improper obvious to try standard, where

what would have been 'obvious to try' would have been to vary all parameters or try each of numerous possible choices [here, the materials for the construction panel] until one possibly arrived at a successful result, where the prior art gave either no indication of which parameters were critical or no direction as to which of many possible choices is likely to be successful....

MPEP§ 2145 X.B. In stating that "the material of construction has been deemed a matter of choice" the Office Action is merely inviting the skilled artisan to try each and every



possible combination of known materials until they achieve the successful result of the claimed invention.

Therefore, Johnston alone cannot state a prima facie case of obviousness for claims 1-6 and applicant respectfully requests the Examiner withdraw this rejection.

Claims 7-16 were also:

rejected under 35 U.S.C. 103(a) as being unpatentable over Johnston (2096968). Johnston lacks all of the materials of construction though, such selections have been deemed a matter of choice. One of ordinary skill in the art would have appreciated all of the materials available for use and would have selected any one which fulfilled the intended purpose of his panel. Nevertheless, Tanaka and Fash *et al.* disclose the materials of construction. It would have been obvious to construct the panel of any of the known materials used today as shown by the two secondary references in order to fulfill the intended purposes and construction of the panel.

This rejection also fails to state a proper prima facie case of obviousness for the reasons stated above. Neither the Office Action nor the references themselves provide a suggestion or motivation or to combine the teachings of the cited references other than the statement “all of the materials [are] available for use[.]” Moreover, Johnston, Tanaka and Fash *et al.* all deal with disparate, non-related articles. Johnston relates to roofing shingles. Tanaka deals with polymer composites suitable “as a backing material for carpets[.]” Col. 1, lines 17-19. Fash *et al.* disclose a fencing product. None of these references, nor the knowledge in the art, provide a teaching or suggestion that materials used for making carpet backings or fencing products are suitable for use in a roofing shingle. In fact, the skilled artisan would recognize that the characteristics of each of these products differ dramatically. This rejection further fails to treat the claimed invention as a whole as well as consider the whole of the cited references. This rejection also judges the claims by the improper obvious to try standard as shown by the statement in the Office Action that “[i]t would have been obvious to construct the panel of any of the known materials used today[.]” This statement simply invites the skilled artisan to



experiment with "any of the known materials used today" until they achieve the successful results achieved by the claimed invention.

With respect to claims 7 and 14, none of the cited references teach or suggest using any of the claimed plant fibers. Regarding claim 12, none of the cited references teach or suggest a construction panel having the claimed impact rating. Regarding claim 13, none of the references teach or suggest a composition comprising the claimed amount of natural plant fiber.

For the foregoing reasons, applicant respectfully submits that the cited references do not state a prima facie case of obviousness of the claimed invention and, therefore, respectfully request the Examiner withdraw these rejections.

CONCLUSION

In view of the above remarks, it is respectfully submitted that this application is in condition for allowance. Early notice to that effect is earnestly solicited. The Examiner is invited to telephone the undersigned at the number listed below if the Examiner believes such would be helpful in advancing the application to issue.

Respectfully submitted,

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By 

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